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09/911,916	07/24/2001	Fabio Casati	10008278-1	4217

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

WOOD, WILLIAM H

ART UNIT PAPER NUMBER

2193

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,916

Applicant(s)

CASATI ET AL.

Examiner

William H. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-16 and 18-31 is/are rejected.
- 7) ☒ Claim(s) 4 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Attached Requirement for Information.

## **REQUIREMENT FOR INFORMATION**

The finality of the last Office Action (18 May 2005) is withdrawn.

### **37 CFR 1.105**

#### **§ 1.105 Requirements for information.**

(a)

- (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:
  - (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
  - (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
  - (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
  - (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
  - (v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
  - (vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.
  - (vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

- (2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.
- (3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.
- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.  
[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

### ***Requirement for Information***

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Upon review of the disclosed prior art **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348, it appears that information directly related to the patentability of the current claims may have been made available to the public through the “eFlow” technology. The specifics of the public disclosure must be analyzed in a determination of applicability under 35 U.S.C. § 102(a,b). Applicant’s previous response (received 21 February 2006) is noted, however it is not understood with relation to the original requirement. Therefore, in view of Applicant’s response, the Requirement for Information is again advanced as indicated below.

In response to this requirement, please provide:

- 1) Factual statement explaining the relationship between specifying a composite e-service and deploying the composite e-service (as recited in the claims) in the “eFlow” platform publicly available April 2000 as evidenced by **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348; and
- 2) Factual statement explaining the operational steps involved in receiving a composite e-service to producing a working deployment for a client, target or customer including use of the mentioned repository (as recited in the claims) in the “eFlow” platform publicly available April 2000 as evidenced by **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348;
- 3) Factual statement explaining the process of deploying the composite e-service in the “eFlow” platform (as recited in the claims) publicly available April 2000 as evidenced by **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348; and

In relation to this requirement, the phrase “eFlow platform” refers to the terminology of the publicly available article **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348. The response to this requirement must take the public knowledge of the “eFlow platform” in to account, regardless of whether “eFlow” was ever released as an application, program, software, product, or service. At the very least the “eFlow platform” was publicly available April 2000 as evidenced by **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”, IEEE-Proceedings Academia/Industry Working Conference on 27-29 April 2000, pp. 341-348.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant’s disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant’s first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information

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disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

### ***Conclusion***

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.



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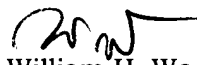
### **Correspondence Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

  
William H. Wood  
Patent Examiner  
AU 2193  
May 12, 2006

  
KAKALI CHAKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

### **DETAILED ACTION**

Claims 1-12 and 14-31 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "at least one electronic service". There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "the business comprising" in line two of the claim. There is insufficient antecedent basis for this limitation in the claim. The claim is interpreted as stating instead, "the electronic business system".

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3, 5-6, 8-12, 14-16, 18-19 and 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Casati** et al., “eFlow: a Platform for Developing and Managing Composite e-Services”.

Claim 1

**Casati** disclosed an electronic metaservice methodology comprising:

receiving a process definition (*page 342, left column, first full paragraph, last two sentences; page 342, figures 2 and 3; page 343, figure 4; illustrations of the service/process definitions*);

transforming the process definition into a composite process specification (*page 341, right column , first full paragraph, “eFlow, that supports the specification, deployment, and management of composite e-services”, eFlow thus is the tool which allows a transformation of a users process definition into the composite specification*) in a format supported by an electronic services platform (*page 341, right column , first full paragraph, “eFlow”*), said composite process specification having a plurality of electronic services (*page 341, right column , first full paragraph, “composite e-services, i.e., of e-services that are carried out by invoking several other basic or composite services”*)

**Casati** did not explicitly state registering the composite process specification with the electronic services platform. **Casati** demonstrated that it was known at the time of invention: to provide an electronic services platform with a repository of processes, nodes and data type definitions (*page 345, beginning*

section 5, “*eFlow* provides a repository of processes, nodes and data type definitions”); to provide an electronic services platform with a service node repository for reuse, in other words saved for later or registered (page 347, left column, second paragraph); and to provide such features to encourage reuse and speed the development of composite services (page 345, midway first paragraph of section 5, “in order to obtain the desired composite service definition”). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the electronic services platform of **Casati** with a registration of composite process specifications in a repository for reuse later as suggested by **Casati**’s own teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to reduce and simplify the work load through reuse of services nodes, composite and basic (page 347, left column, second paragraph).

### Claim 2

**Casati** disclosed the methodology as set forth in claim 1, said transforming further comprising:

determining which elements of the process definition constitute specific electronic services and designating said elements as linked service nodes of a continuous flow defining said composite process specification (*page 343, section 3, left column, bottom, “Visually, a composite service is modeled by a graph that defines the overall flow of service execution ...”*).

Claim 3

**Casati** disclosed the methodology as set forth in claim 2 wherein said designating comprises:

configuring each of said service nodes with service invocation setup requirements for an associated one of said electronic services (*page 344, first paragraph under section 4.1, "configuration parameter"*).

Claim 5

**Casati** disclosed the methodology as set forth in claim 1, said registering further comprising:

establishing a repository of defined composite electronic services (*page 347, left column, second paragraph, "service node repository", where service nodes are basic and composite services, see page 343, right column, second full sentence*).

Claim 6

**Casati** disclosed the methodology as set forth in claim 5, said transforming further comprising:

using said defined composite electronic services in said repository for configuring other composite electronic services (*page 347, left column, second paragraph, "eMove" composite service*).

Claim 8

**Casati** disclosed the methodology as set forth in claim 1 further comprising:

providing ancillary functions selected from a group including: changing the process, managing individual electronic service definitions, monitoring run-time executions, and obtaining analytical-statistical reports regarding said process (*page 341, Abstract, bottom, “eFlow includes components that allow users to monitor, analyze, and modify a service...” and section 1; page 345, left column, first full paragraph*).

Claim 9

**Casati** disclosed the methodology as set forth in claim 1 further comprising:

allowing service providers to invoke a composite process defined by said composite process specification as an individual electronic service via said electronic services platform (*page 344, right column, first full paragraph; companies provide personalized services, eFlow allows creation and modification of these services; page 345, left column, first full paragraph, “retrieves the latest service node definitions from the repository”; page 343, right column, second sentence, “Service nodes represent the invocation of a basic or composite service”*).

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Claim 10

**Casati** disclosed the methodology as set forth in claim 1 in an internet environment (*page 341, section 1, “using the Web to communicate with their partners, to connect with their back-end systems, and to perform electronic commerce transactions”*).

Claim 11

**Casati** disclosed the methodology as set forth in claim 1 wherein said at least one electronic service is an electronic services platform (*page 342, figures 1-3, service providers providing services*).

Claim 12

**Casati** disclosed the methodology as set forth in claim 1 wherein said at least one electronic service is an electronic service directory (*page 344, section 4.1, second paragraph, “custoMove”*).

Claims 14-16, 18-19 and 21-22

The limitations of claims 14-16, 18-19 and 21-22 correspond to claims 1-12 and as such are rejected in the same manner.

Claim 23

**Casati** disclosed an electronic business system for an electronic services platform environment, the business comprising:

means for receiving a specification of a first electronic service (*page 342, left column, first full paragraph, last two sentences; page 342, figures 2 and 3; page 343, figure 4; illustrations of the service/process definitions*);

means for compiling other existing secondary electronic services into the first electronic service (*page 341, right column, first full paragraph, "eFlow, that supports the specification, deployment, and management of composite e-services", eFlow thus is the tool which allows a transformation of a users process definition into the composite specification*);

means for structuring said first electronic service to be compatible with a given electronic services platform (*page 341, right column, first full paragraph, "eFlow"*)

**Casati** did not explicitly state means for registering said first electronic service in the electronic services platform environment. **Casati** demonstrated that it was known at the time of invention: to provide an electronic services platform with a repository of processes, nodes and data type definitions (*page 345, beginning section 5, "eFlow provides a repository of processes, nodes and data type definitions"*); to provide an electronic services platform with a service node repository for reuse, in other words saved for later or registered (*page 347, left column, second paragraph*); and to provide such features to encourage reuse



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and speed the development of composite services (page 345, midway first paragraph of section 5, “in order to obtain the desired composite service definition”). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the electronic services platform of **Casati** with a registration of composite process specifications in a repository for reuse later as suggested by **Casati**’s own teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to reduce and simplify the work load through reuse of services nodes, composite and basic (page 347, left column, second paragraph).

#### Claim 24

**Casati** disclosed the system as set forth in claim 23 further comprising:

- ♦ means for defining said specification (*page 343, section 3, “In eFlow a composite service is described ... Visually, a composite service is modeled by a graph that defines the overall flow of service execution ...”*).

#### Claim 25

**Casati** disclosed the system as set forth in claim 23 further comprising:

- ♦ means for forming a repository of a plurality of electronic services of a type of said first electronic service (*page 347, left column, second paragraph, “service node repository”, where service nodes are basic*

*and composite services, see page 343, right column, second full sentence; of type composite).*

Claim 26

**Casati** disclosed the system as set forth in claim 23 further comprising:

- ♦ means for providing a work flow representative of said first composite electronic service such that said work flow is compatible with said electronic services platform structure *(page 343, section 3, "In eFlow a composite service is described ... Visually, a composite service is modeled by a graph that defines the overall flow of service execution ...").*

Claim 27

**Casati** disclosed the system as set forth in claim 26 further comprising:

- ♦ means for providing an interaction gateway between said means for providing a work flow and said electronic services platform *(page 344, second paragraph under section 4.1, custoMove provides interface/gateway for defining generic service flows).*

Claim 28

**Casati** disclosed the system as set forth in claim 23 further comprising:

- ♦ means for monitoring said first electronic service (*page 341, Abstract, bottom, “eFlow includes components that allow users to monitor, analyze, and modify a service...” and section 1; page 345, left column, first full paragraph*).

Claim 29

**Casati** disclosed the system as set forth in claim 23 further comprising:

- ♦ means for maintaining said first electronic service (*page 341, Abstract, bottom, “eFlow includes components that allow users to monitor, analyze, and modify a service...” and section 1; page 345, left column, first full paragraph*).

Claim 30

**Casati** disclosed the system as set forth in claim 29 further comprising:

- ♦ means for updating said first electronic service after registration with said electronic services platform (*page 344, first paragraph under section 4.1; page 345, first paragraph under section 4.2; page 347, second paragraph left column*).

Claim 31

**Casati** disclosed the system as set forth in claim 29 further comprising:

- ♦ means for deleting said first electronic service from registration with said electronic services platform (*page 345, left column, first full paragraph; "services ... removed"*).

5. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Casati** et al., "eFlow: a Platform for Developing and Managing Composite e-Services" in view of Web Services Flow Language (**WSFL** 1.0).

Claim 7

**Casati** did not explicitly state receiving said process definition as a process flow language for composing e-services. **WSFL** demonstrated that it was known at the time of invention to provide composite web services in a process flow language (page 6, section 1, Introduction). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the composite service definitions of **Casati** with being described using **WSFL**. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make use of an off the shelf solution to standardized business process defining (page 6, section 1, note XML used for *business process*).

**Allowable Subject Matter**

6. Claims 4 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

7. Applicant's arguments filed 08 August 2005 have been fully considered but they are not persuasive. Though a new rejection has been issued, some of Applicant's previous remarks may be pertinent, and therefore are addressed. Applicant argued: 1) **Casati** fails to disclose deployment; 2) **Casati** fails to disclose registration; 3) **Casati** does not teach transforming the definition into a format supported by an electronic services platform; and 4) **Casati** not enabled to practice the claimed invention.

First, Applicant contends (page 9, second paragraph) the **Casati** reference fails to disclose deployment. However, the claim language does not require deployment. Additionally, the article, as Applicant notes, does state "a platform ... that supports the specification, deployment, and management of composite e-services".

Second, Applicant asserts (page 10, first full paragraph) **Casati** fails to provide registration as called for in the independent claim 1. This argument is made moot in view of the new rejections (see above).

Third, Applicant contends (page 10, second full paragraph) **Casati** fails to transform the definition into a composite process specification in a format

supported by an electronic services platform. This is clearly demonstrated as the above rejections indicate. eFlow creates a representation of composite e-services (page 341, right column, first full paragraph) from the service developer specified business process/service (page 341, abstract, second paragraph). A user creating and recording an eFlow service from a desired business process/service, is the transforming step. Inherency is not an issue. The article describes transforming from concept to eFlow specified service.

Fourth, Applicant contends (page 12, second full paragraph), **Casati** “is not a proper anticipatory prior art reference as it does not enable the practice of the claimed invention”. This is unpersuasive for at least the reason that Applicant has not offered evidence of “undue experimentation” by one of ordinary skill in the art, which is an essential element of a proper enablement analysis (see MPEP 2164). Applicant has merely stated what Applicant believes is lacking in regard to technical detail, not what technical detail one of ordinary skill in the art would bring to a reading of **Casati**. Finally, as indicated above, the technical detail of **Casati** is not lacking.

Finally, Applicant is kindly requested to provide “eFlow Model and Architecture”, version 1.0, 1999 by Hewlett-Packard as cited by the **Casati** article.

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William H. Wood  
Patent Examiner  
AU 2193  
May 15, 2006